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Case No.: 55526US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: FLANIGAN, PEGGY-JEAN P.
Application No.: 09/974710 Confirmation No.: 7863
Filed: October 9, 2001 Group Art Unit 1794
Title: LAMINATES WITH STRUCTURED LAYERS

REPLY BRIEF TO EXAMINER'S ANSWER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

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CERTIFICATE OF TRANSMISSION [37 CFR § 1.8(a)]

I hereby certify that this correspondence is being transmitted to United States Patent and Trademark Office on the date shown below via the Office electronic filing system.

July 12, 2010 /Kim Elfstrom/
Date Signed by: Kim Elfstrom

Dear Sir:

In response to the Examiner's Answer dated May 18, 2010, applicants submit this Reply Brief. Applicants only address the Examiner's new points of argument.

Fees

- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- ☒ Please credit any overpayment to the same deposit account.

REMARKS

Reply to Examiner's Response to Argument

First Ground of Rejection

The first ground of rejection is that the present claims are obvious over the Hata-1 reference (JP 11-181367 or WO 99/24519) which teaches protective tape articles with void volumes in range 1-600 mm³. Appellants have stated that Hata-1 not only does not teach void volumes of less than 20 nL (1 mm³ equals 1,000nL) but teaches away from these void volumes by teaching that volumes of less than 1 mm³ (1,000 nL) would reduce the heat shielding and vibration resistance.

Examiner has cited MPEP 2123 (II) to state that Hata-1 does not teach away from the void volumes of present claims (less than 20 nL) with teaching that volumes of less than 1 mm³ (1,000 nL) would reduce the heat shielding and vibration resistance. Rather the Examiner states that articles with the void volumes of the present claims are merely non-preferred embodiments. MPEP 2123 (II) states in part that: "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

The Examiner is incorrect in stating that the void volumes of less than 20 nL are merely non-preferred embodiments of Hata-1. Hata never teaches void volumes of 20 nL at all, nor any range even close to this void volume. One of ordinary skill in the art would not look at the range of volumes taught by Hata-1 (1-600 mm³) combined with the additional teaching of Hata-1, that volumes of less than 1 mm³ (1,000 nL) would reduce the heat shielding and vibration resistance to produce articles with void volumes of less than 20 nL to generate working embodiments of the Hata-1 disclosure.

Further, the Examiner's argument is not applicable because the articles of Hata-1 and the present claims are not products for the same use. The articles of Hata-1 are protective adhesive tapes when applied to an adherend such as window glass can simultaneously provide the effects of preventing breakage and fragment scattering, as well as heat shielding, soundproofing and vibration resistance (see for example, the abstract of Hata-1). The articles of the present claims are not designed for this function. From the teachings of Hata-1, combined with ordinary skill in the art, one would not expect smaller void volumes to provide the cushioning effect desired and taught in Hata-1. Nor would one, from the teachings of Hata-1 combined with ordinary skill in

the art, expect the articles of the present claims to function as protective tapes of Hata-1. Therefore, without the teachings of the present disclosure one would not look to the teachings of Hata-1 to prepare articles with void volumes of less than 20 nL.

Second Ground of Rejection

The second ground of rejection is that the present claims are obvious over the combination of Hata-1 reference (JP 11-181367 or WO 99/24519) and Hata-2 (WO 97/33946). Hata-1 teaches protective tape articles with void volumes in range 1-600 mm³. Hata-2 teaches cushioning adhesive sheets with void volumes in range 0.8-600 mm³. Appellants have stated that Hata-1 and Hata-2 not only do not teach void volumes of less than 20 nL (1 mm³ equals 1,000 nL) but teaches away from these void volumes by teaching that volumes of less than 1 mm³ (1,000 nL) would reduce the heat shielding and vibration resistance.

Examiner has cited MPEP 2123 (II) to state that Hata-1 does not teach away from the void volumes of present claims (less than 20 nL) with teaching that volumes of less than 1 mm³ (1,000 nL) would reduce the heat shielding and vibration resistance. Rather the Examiner states that articles with the void volumes of the present claims are merely non-preferred embodiments.

The Examiner is incorrect in stating that the void volumes of less than 20 nL are merely non-preferred embodiments of Hata-1 for the reasons given above. Combination with Hata-2 does not remedy the teaching away of Hata-1, in fact it makes the teaching away even clearer. For example, the abstract of Hata-2 states: “A cushioning adhesive sheet for which the cushioning ability is not likely to be deteriorated with time, by applying an airtight space having a comparatively large volume on an adherend and maintaining the airtight space stably with time.” (emphasis added). Therefore, without the teachings of the present disclosure one would not look to the teachings of Hata-1 and/or Hata-2 to prepare articles with void volumes of less than 20 nL.

In view of the above, applicants respectfully submit that the Examiner has erred in maintaining the rejection under 35 USC § 103(a). Please reverse the decision below.

Respectfully submitted,

July 12, 2010

Date

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